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Tom McCarthy

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EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3685

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/622,146	Applicant(s) MCCARTHY ET AL.	
	Examiner CRISTINA SHERR	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 and 46-83 is/are pending in the application.
- 4a) Of the above claim(s) 14-36, 41 and 46-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/6/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed May 26, 2009. Claims 1 and 41 have been amended. Claim 45 has been canceled. Claims 1-44 and 46-83 are currently pending in this case. Claims 1-13 and 37-40 are under examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 6, 2009 has been entered.

Election/Restrictions

3. Applicant's election of Invention I, claims 1-13 and 37-40 in the reply filed on May 26, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on February 6, 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

Art Unit: 3685

5. Applicant's arguments filed February 6, 2009 have been fully considered but they are not persuasive.

6. Applicant argues, regarding claim 1, as currently amended, that nothing in the cited prior teaches, discloses or suggests media content that is "unrenderable due to digital rights".

7. Examiner respectfully disagrees and directs attention to firstly to Hendricks, disclosing a system for rendering media content (e.g. abs) comprising a first platform for storing media content, wherein the media content comprises an unrenderable (e.g. encrypted) state when received by the first platform (e.g. fig 3, 202 and 220; column/line 8/57-9/42; column 10, lines 36-40). Hendricks does not specifically disclose wherein the media content is stored at the subscriber location where it is later made renderable either through payment (payment is the equivalent of acquiring rights which did not exist before) or other means. Gaske, however, does, at, e.g. fig 3 showing a set top box equipped for storing or caching encrypted programming for later playback (also par 8, 9, 31, 32, 33). It would be obvious to one of ordinary skill in the art to combine the teachings of Hendricks and Gaske since both are in the field of rendering media content and in order to provide for local storage of media in the event of network failure while preserving security, and also in order to playback media at any time rather than at scheduled intervals.

8. Applicant argues, regarding claim 1, as currently amended, that nothing in the cited prior teaches, discloses or suggests "a discovery service operable to search for stored media content and to download content based on a content profile".

Art Unit: 3685

9. Examiner respectfully disagrees. Hendricks discloses downloading content based on a content profile (e.g. col 16 ln 45-53). Gaske discloses searching downloaded and stored media content in order to decrypt and render content based on rights. (par 9, 61, 62, 63). It would be obvious to one of ordinary skill in the art to combine the teachings of Hendricks and Gaske since both are in the field of rendering media content and in order to provide for local storage of media in the event of network failure while preserving security, and also in order to playback media at any time rather than at scheduled intervals.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-13 and 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. In this case, independent claims 1 recites a first and a second platform, as well as a discovery or search service without reciting or explaining how the discovery or search service is related to either one of the two platforms. For this reason, in dependent claim 1 and its dependent claims 2-13 and 37-40 are rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3685

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-13 and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (US 5,659,250) in view of Gaske et al (EP 1 100 266 A2).

15. Regarding claim 1—

16. Hendricks discloses a system for rendering media content (e.g. abs) comprising: a first platform for storing media content, wherein the media content comprises an unrenderable (e.g. encrypted) state when received by the first platform (e.g. fig 3, 202 and 220; column/line 8/57-9/42; column 10, lines 36-40);

a second platform communicatively coupled with the first platform for rendering the stored media content (e.g. fig 3, 222);

the first and second platforms cooperatively providing an interface for purchasing a right to render the stored media content at least one time (e.g. fig 3, 900); and

at least one of the first platform and the second platform being operable to convert the stored media content to a renderable state upon the purchase of the right to render.

(e.g. col 10 ln 57-67).

17. Hendricks does not disclose wherein the media content is stored at the subscriber location where it is later made renderable either through payment or other means. Gaske, however, does, at, e.g. fig 3 showing a set top box equipped for storing or caching encrypted programming for later playback. It would be obvious to one of ordinary skill in the art to combine the teachings of Hendricks and Gaske since both are

Art Unit: 3685

in the field of rendering media content and in order to provide for local storage of media in the event of network failure while preserving security.

18. Hendricks discloses downloading content based on a content profile (e.g. col 16 ln 45-53). Gaske discloses searching downloaded and stored media content in order to decrypt and render content based on rights. (par 9, 61, 62, 63). It would be obvious to one of ordinary skill in the art to combine the teachings of Hendricks and Gaske since both are in the field of rendering media content and in order to provide for local storage of media in the event of network failure while preserving security, and also in order to playback media at any time rather than at scheduled intervals.

19. Regarding claim 2 –

20. Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to receive requests for content and to responsively retrieve content from the content sources (e.g. col 11 ln 20-45).

21. Regarding claim 3 –

22. Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one Content source (e.g. fig 2, 212), the distribution server being operable to track the usage of the content. (e.g. col 11 ln 47-55).

23. Regarding claim 4 –

24. Hendricks discloses the system of claim 1 further comprising: a distribution server connected to at least one of the first and second platforms and to at least one

Art Unit: 3685

content source, the distribution server being operable to track the payment of the content. (e.g. col 11 ln 47-55).

25. Regarding claim 5 –

26. Hendricks discloses the system of claim 1 further comprising: distribution server connected to at least one of the first and second platforms and to at least one content source, the distribution server being operable to track the commerce of the content. (e.g. col 11 ln 47-55).

27. Regarding claim 6 –

28. Hendricks discloses the system of claim 1, wherein the first platform comprises a digital video recorder device that includes a storage device for storing the media content. (e.g. col 10 ln 57-67).

29. Regarding claim 7 –

30. Hendricks does not directly disclose a storage device specifically comprising a hard disk. Official Notice is taken having a storage device comprising a hard disk drive is old and well-known. Thus it would have been obvious to one of ordinary skill in the art to combine Hendricks with such a storage device given how common, economical, easy to find and use such hard disk drives are.

31. Regarding claim 8 –

32. Hendricks discloses as discussed above but Hendricks does not specifically disclose wherein the first platform comprises a personal computer that includes a storage device for storing the media content. However, Official Notice is taken that the functions of a set top terminal are functions that old and well known to be performed by

Art Unit: 3685

a personal computer. Thus, it would be obvious to one of ordinary skill in the art at the time the invention was made to have a personal computer act as set-top terminal since this would make integral in one unit which might otherwise be done in two devices. Moreover, the resulting combination is predictable and would allow for recording of content on the computer.

33. Regarding claims 9-10 –

34. Hendricks does not specifically disclose the limitations of claims 9 and 10.

However, Official Notice is taken that a storage device comprising an optical storage device, such as a digital versatile disk (DVD) drive is old and well-known. Thus it would have been obvious to one of ordinary skill in the art to combine Hendricks with such a storage device given how common, economical, easy to find and use such DVD's are.

35. Regarding claim 11 –

36. Hendricks discloses the system of claim 1, wherein the unrenderable state comprises a first level of encryption that protects the media content from unauthorized rendering. (e.g. col 11 ln 20-45).

37. Regarding claim 12 –

38. Hendricks discloses the system of claim 11, wherein the media content is contained in a broadcast signal and the unrenderable state comprises a second level of encryption that protects the media content from unauthorized reception and storage. (e.g. col 9 ln 18-40).

39. Regarding claim 13 –

Art Unit: 3685

40. Hendricks discloses the system of claim 12, wherein the broadcast is one of an over-the-air broadcast, a cable broadcast, an Internet broadcast and a satellite broadcast, and receiver therefor (e.g. col 1 ln 28-32).

41. Regarding claim 37 –

42. Hendricks discloses the system of claim 1, wherein the media content is stored on the first platform in a compressed format. (e.g. col 11 ln 20-45).

43. Regarding claims 38-39 –

44. Hendricks does not specifically disclose the various MPEG standards and layers thereof. However, Hendricks does contemplate using MPEG compressions standards generally. (e.g. col 6 ln 44-54, col 8 ln 23-38, col 9 ln 35-45, col 13 ln 56-61, col 14 ln 48-65). It would be a predictable result obvious to one of ordinary skill in the art at the time the invention was made to include various MPEG standards and layers thereof for the compressed format. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

45. Regarding claim 40 –

46. Hendricks discloses the system of claim 1, wherein the first platform comprises: a digital video recorder having a storage device for retaining, at least a portion, of the media content; (e.g. col 11 ln 20-45).

a personal computer operatively coupled with the digital video recorder, wherein the personal computer provides (e.g. col 13 ln 37-46) for:

the purchase of the right to render the media content; management of rendering of the media content including:

Art Unit: 3685

enforcing digital rights associated with the media content; and
controlling rendering of the media content in correspondence with terms of the
purchase. (e.g. col 15 ln 20-50)

Conclusion

47. The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure.

48. "Computers and How They Work", by Roderick Hames, Copyright© 1998, Alton
C. Crews Middle School: CS Dept – Articles

(<http://www.crews.org/curriculum/ex/compsci/articles/howcomput.htm>).

49. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to CRISTINA SHERR whose telephone number is
(571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through
Friday.

50. If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone
number for the organization where this application or proceeding is assigned is 571-
273-8300.

Art Unit: 3685

51. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
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Art Unit 3685

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